

REMARKS

In the Final Office Action, the Examiner rejected claims 1-20. By this paper, Applicants have added new claims 21-24 and amended claims 1 and 9 for clarification of certain features to expedite the allowance of the present application. These amendments do not add any new matter. Upon entry of these amendments, claims 1-24 are pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections under 35 U.S.C. § 102(e)

In the Office Action, the Examiner rejected claims 1-20 under 35 U.S.C. § 102(e) as anticipated by Zalewski et al. (U.S. Patent No. 6,647,508 B2). Applicants respectfully traverse these rejections.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Second, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (emphasis added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997).

Claims 1 -8

Turning to the claims, independent claim 1 recites “tabulating resources of the computing device *into one or more resource tables*,” and “allocating resources *from one or more of the resource tables* to a plurality of resource sets.” (Emphasis added). In sharp contrast, the Zalewski reference discloses a system wherein a “master console creates and initializes the partitions *based on...environment variables*,” which define the system partitions. *See* Zalewski, col. 8, lines 8-11 (emphasis added). The Zalewski reference provides no additional guidance as to the structure or characteristics of the “environmental variables” that form the basis of the partitions, and the Zalewski reference provides absolutely no teaching or suggestion that these environment variables are “resource tables,” as recited in claim 1. In fact, the Zalewski reference only mentions the

word “table” with regard to device configuration tables, which are clearly different than the “resource tables” recited in independent claim 1. For at least this reason, Applicants respectfully assert that independent claim 1 is not anticipated by the Zalewski reference. Accordingly, Applicants respectfully request that the Examiner withdraw the Section 102 rejection against claims 1-8.

Dependent Claims 2 and 3

Claim 2 recites the method of claim 1 “wherein allocating resources comprises organizing the resources in a ROM-based environment.” Claim 3 recites the method of claim 2 “wherein organizing the resources in the ROM-based environment comprises gathering device data from a BIOS module.” In rejecting each of these claims, the Examiner relied on a theory of inherency. *See* Office Action, page 4 and page 6. For example, in rejecting claim 3, the Examiner stated that it is “inherent to the system as a BIOS contains the important device data.” *Id.* In response to these rejections, Applicants stress that if the Examiner relies upon a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). As such, Applicants respectfully assert that the features of claims 2 and 3 are not inherent and stress that the Examiner has not provided evidence or scientific reasoning to support the Examiner’s assertion of inherency. For this reason, in addition to the reasons outlined above, Applicants respectfully request withdrawal of the rejections of claims 2 and 3 under 35 U.S.C. § 102.

Claims 9-13

Independent claim 9, as amended, recites “dividing the resources into multiple subsets prior to O/S booting wherein dividing the resources comprises *partitioning the resources with an extensible firmware interface.*” (Emphasis added). In sharp contrast,

the Zalewski reference does not even mention an extensible firmware interface. As such, the Zalewski reference cannot anticipate the features of independent claim 9 or its dependent claims. Accordingly, Applicants respectfully request withdrawal of Examiner's rejections and allowance of claims 9-13.

Claim Rejections under 35 U.S.C. § 102(f)

In the Office Action, the Examiner rejected claims 14-20 under 35 U.S.C. § 102(f) as anticipated by the Doran reference. Applicants respectfully traverse these rejections.

As an initial matter, Applicants assert that the rejection under 35 U.S.C. § 102(f) is improper. A rejection under 35 U.S.C. § 102(f) is only proper where "it can be shown that an applicant 'derived' an invention from another." M.P.E.P. 2137 *citing Ex Parte Kusko* 215 U.S.P.Q. 972, 974, (B.P.A.I. 1981). This derivation "requires complete conception by another and *communication of that conception* by any means to the party charged with derivation." *Id. citing Kilbey v. Thiele*, 199 U.S.P.Q. 290, 294 (B.P.A.I. 1978). As such, because the Examiner has *provided absolutely no evidence* of any communication between Applicants and the authors of the Doran reference, it was improper for the Examiner to reject claims 14-20 under 35 U.S.C. § 102(f). Accordingly, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102(f) against claims 14-20.

Further, Applicants also request that the Examiner withdraw the Section 102(f) rejections against claims 14-20, because the Doran reference clearly does not anticipate these claims. For example, independent claim 14 recites "an extensible firmware interface comprising...a resource divider module configured *to create multiple resource sets.*" (Emphasis added). Independent claim 14 also recites "an operating system loader module configured to load a desired operating system on each of the multiple resource sets." While Applicants acknowledge that the Doran reference discloses an extensible

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firmware interface, Applicants respectfully note that the extensible firmware interface disclosed in the Doran reference is purely conventional and, as such, clearly lacks the above-recited features of claims 14-20. Moreover, the Examiner has not provided a citation to any evidence that the Doran reference even discloses the above-described claim features. As such, the Doran reference cannot anticipate the features of independent claim 14 or the claims that depend therefrom. Accordingly, Applicants respectfully request the withdrawal of the Examiner's rejections and allowance of claims 14-20.

New Claims

Applicants respectfully request entry and consideration of new claims 21-24. The new claims are fully supported by the specification and Applicants respectfully submit that the prior art of record does not disclose or suggest the recited subject matter of new claims 21-24. For example, Applicants assert that neither of the cited references discloses "a system comprising...an interrupt controller module configured to detect and deliver interrupts to at least one of the operating systems through a peripheral components interconnect ("PCI") bus," as recited in claim 21. For at least this reason, Applicants respectfully submit that new claims 21-24 are allowable over the cited references taken alone or in combination with each other.

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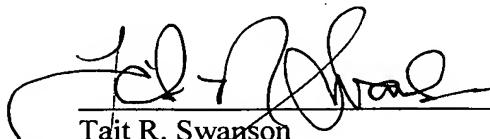
Removal of Zalewski under 35 U.S.C. § 103(c)

Applicants also respectfully remind the Examiner that the Zalewski reference (cited in the Final Office Action under 35 USC 102(e)) *would not qualify* as prior art under 35 U.S.C. § 103(a). Specifically, Applicants note that the Zalewski reference, if applied under section 103(a), would be removable in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and the Zalewski reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to Compaq Information Technologies Group L.P., now a wholly owned affiliate of Hewlett Packard Company.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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